

Applicant traverses the restriction between Inventions I and II on the grounds that the Examiner did not state any reasons for requiring restriction between Inventions I and II. Instead, the Examiner only gives reasons for requiring restriction between Inventions II and III. In the instant Office Action, the Examiner merely states, "The Inventions are distinct, each from the other because of the following reasons: Inventions II, III, IV, and I are related as subcombinations disclosed as usable together in a single combination". Applicant reminds the Examiner that according to MPEP 808.01:

The particular reasons relied on by the Examiner for holding that the Inventions as claimed are either independent or distinct should be concisely stated. **A mere statement of conclusion is inadequate.** The reasons upon which the conclusion is based should be given.

For example, relative to a combination and a subcombination thereof, the Examiner should point out the reasons why he or she considers the subcombination to have utility by itself or in other combinations and why he or she considers that the combination as claimed does not require the particulars of the subcombination as claimed.

Each relationship of claimed Inventions should be similarly treated and the reasons for the conclusions of distinctness or independence set forth. (emphasis added)

Therefore, Applicants request that the restriction requirement between Inventions I and II be removed on the grounds that the Examiner has failed to provide any reasons whatsoever for requiring restriction between Inventions I and II.

Similarly, **Applicant traverses the restrictions between Inventions I and III, I and IV, II and IV, and III and IV.** As stated above, the Examiner only provided reasons for requiring restriction between Inventions II and III, and failed to provide any reasons for the above listed restrictions. Therefore, Applicants request that the restriction requirements between Inventions I and III, I and IV, II and IV, and III and IV be removed on the grounds that the Examiner has failed to provide any reasons whatsoever for requiring these restrictions.

Furthermore, Applicant respectfully submits that the alleged Inventions are not disclosed as *subcombinations* usable together *in a single combination*. Instead, all of the alleged Inventions describe methods or systems which allow a device to receive an instrument driver to communicate with an instrument. For example, claim 1, of alleged Invention I, allows a second device to receive an instrument driver from a network to communicate with a traditional instrument. Similarly, claim

23, of alleged Invention II, allows a first device to receive an instrument driver from a network to communicate with a first traditional instrument; claim 33, of alleged Invention III, allows a first device to receive an instrument driver from the Internet to communicate with a traditional instrument; and finally, claim 70, of alleged Invention IV, allows a first device to receive an instrument driver to communicate with a traditional instrument. Thus, Applicant respectfully submits that, although Inventions I, II, III, and IV, may certainly vary in scope with respect to each other, the Examiner has mischaracterized Applicant's alleged Inventions as separate subcombinations usable together in a single combination. Thus, the restriction is improper. Applicant submits that a difference in terminology or scope between claims does not mean that the claims are limited to separate subcombinations.

Applicant also reminds the Examiner that a proper restriction requirement under M.P.E.P. § 806.05(d) requires that the subcombinations "do not overlap in scope". As discussed above, there is clearly overlap in scope between the claims of alleged Inventions I, II, III, and IV. However, Applicant is by no means asserting that the scope of the claims of Inventions I, II, III, and IV are identical. In fact, there are clearly differences in scope between the claims. However, some of the claims of Inventions I, II, III, and IV do have some overlap in scope. For example, Applicant respectfully submits that it is readily apparent that claim 1 (Invention I) and claim 23 (Invention II) both recite similar methods overlapping in scope, not separate subcombinations. Since claims of Inventions I, II, III, and IV have some overlap in scope, restriction cannot be required under M.P.E.P. § 806.05(d). Therefore, Applicant respectfully submits that the Examiner's restriction requirement is improper.

Furthermore, according to M.P.E.P. § 806.05(d), to state a proper restriction requirement for subcombinations usable together in a single combination, "[t]he Examiner must show, by way of example, that one of the subcombinations has utility other than in the disclosed combination." Moreover, M.P.E.P. § 806.05(d) also states that "the burden is on the Examiner" to make this showing. In the instant Office Action, the only reasons stated by the Examiner for the restriction (between Inventions II and III only, as mentioned above) are:

In the instant case, Inventions II and III have separate utilities such as the first device including an Internet server providing web pages, the first device not coupled to the traditional instrument via the Internet, the instrumentation bus not being the Internet, and the second device initiate monitor and control functions of the first traditional instrument.

Applicant respectfully submits that the Examiner has failed to provide an example where one of the subcombinations has utility other than in the disclosed combination. Instead, the Examiner has merely listed various elements of claim 23 and claim 33. As stated above, “the Examiner must show, by way of example, that one of the subcombinations has utility other than in the disclosed combination”. Applicant respectfully submits that listing elements of two claims of the instant Application is not showing an example of one subcombination having a utility other than in the disclosed combination. Thus, Applicant respectfully submits that the Examiner has failed to meet the requirement of M.P.E.P. § 806.05(d) to “document a viable separate utility”. Therefore, the restriction requirement between Inventions I, II, III, and IV must be withdrawn. Furthermore, as argued above, Applicant submits that the alleged Inventions are not subcombinations usable together in a single combination.

Applicant notes that the Examiner attempts to justify the restriction requirement by stating in the instant Office Action that Invention I is classified in class 709, subclass 223; Invention II is classified in class 709, subclass 208; Invention III is classified in class 709, subclass 203; and Invention IV is classified in class 709, subclass 227. However, simply being classified in different subclasses does not satisfy the requirements of M.P.E.P. § 806.05 to establish a proper restriction requirement. Furthermore, Applicant respectfully submits that the Examiner’s classification is not accurate, as discussed in more detail below.

Applicant also reminds the Examiner that, according to M.P.E.P. § 808, the Examiner is required to also show “reasons why there would be a serious burden on the examiner if restriction is not required”. In regard to this requirement, the Examiner stated in the instant Office Action “because these Inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper”. Applicant respectfully submits that the Examiner has not provided reasons supporting the provided statement “[these Inventions] have acquired a separate status in the art because of their recognized divergent subject matter”, nor has the Examiner provided reasons why this would necessarily cause “a serious burden on the examiner if restriction is not required”. The Examiner appears to rely on the provided classifications, i.e., that each of the

alleged Inventions fall under separate subclasses of class 709, to establish this burden; however, the Examiner's reliance on a different classification to show a separate status in the art is misplaced because the purported classifications are inaccurate and not separate for the claim groups.

For example, the Examiner has classified Invention I under subclass 223 which relates to "managing the resources of the computers connected by a computer network or of the network itself". Applicant respectfully submits that this classification could also be applied to claims in Inventions II, III, or IV, which all relate to providing an instrument driver (via a network) to a device for communication with an instrument.

The Examiner classified Invention II under subclass 208 which relates to "one or more computers (i.e., master computers) regulates the operations of one or more of the other computers (i.e., slave computers)". Applicant submits that the claims classified in Invention II do not specifically require master computers and slave computers, and instead, in claim 56, for example, requests may be sent to the device to monitor or control the traditional instrument. Additionally, Applicant respectfully submits that although the claims from Inventions I, III, and IV may not require this monitoring and controlling limitation, they do not exclude this possibility. Applicant notes again that the claims of Inventions I, II, III, and IV are all related to providing an instrument driver to a device for communications, and the control functionality indicated by the Examiner is provided as an additional limitation on the claims.

The Examiner classified Invention III under subclass 203 which relates to "at least one local computer provides a user interface and performs local data processing to interact with at least one remote computer which implements data processing (e.g., data management, data sharing) within a generic time-sharing environment in response to the local computer to transfer data between the local computer and the remote computer". Applicant notes that again, Invention III is directed to providing an instrument driver to a device to communicate with an instrument, and includes an additional limitation for allowing accessing of the instrument via web pages. Similar to above, Applicant submits that while Inventions I, II, and IV do not specifically include this limitation, they do not exclude this possibility.

Furthermore, the Examiner classified Invention IV under subclass 227 which relates to "creating a session connection between the computers". Applicant notes that this is not recited specifically in the claims of alleged Invention IV, and furthermore, similar to above, that the claims of Invention I, II, III, and IV do not preclude this possibility.

Applicant respectfully submits that, as shown above, the Examiner's classification are not accurate and that the Examiner has not established that separate classifications apply to the claim groups. Since the purported classifications are not accurate and several relate to all of the claim groups, Applicant submits that the Examiner cannot rely upon these classifications to establish "a serious burden on the examiner if restriction is not required." See M.P.E.P. § 808. Since the Examiner has failed to establish a "serious burden on the examiner if restriction is not required", Applicant submits that the Examiner has not established all of the necessary elements of a *prima facie* restriction requirement as required by M.P.E.P. § 808. Therefore, Applicant respectfully requests that the Examiner withdraw the restriction requirement.

CONCLUSION

The present response is believed to be a complete response to the issues raised in the office action in full reconsideration. A favorable reaction is respectfully requested. If the Examiner has any questions, comments or suggestions, the undersigned attorney earnestly requests a telephone conference.

If any extensions of time (under 37 C.F.R. § 1.136) are necessary to prevent the above referenced application(s) from becoming abandoned, Applicant(s) hereby petition for such extensions. If any fees are due, the Commissioner is authorized to charge said fees to Meyertons, Hood, Kivlin, Kowert & Goetzel PC Deposit Account No. 50-1505/5150-46100/JCH.

Respectfully submitted,



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